

Dr. Boesen

Attorney Docket No. P03999US8

REMARKS**Overview**

Claims 1-21 are pending in this application. Claims 1-4, 7-9, 12-16, and 19-21 have been amended. The present response is an earnest effort to place all claims in proper form for immediate allowance.

Examiner Interview

The Applicant thanks the Examiner for the courtesy extended during the personal interview of November 20, 2003. The Applicant agrees with the substance of the interview set forth in Form PTOL-413.

Terminal Disclaimer

A Terminal Disclaimer is being filed herewith to remedy the potential for obviousness type double patenting discussed in the Interview Summary.

Issues Regarding Specification

The Examiner has objected to the Specification for failure to provide antecedent basis for the claimed subject matter (Office Action, page 2). In particular, the Examiner believes that there is not proper antecedent basis for claim 19 which recites "a transmitter . . . for simultaneously transmitting" in line 11 (Office Action, page 2). The Applicant respectfully disagrees. In particular, the Applicant points out that the application specifically discloses that the air conduction sensor 30 and the bone conduction sensor 24 are operatively connected to a stereo transceiver or separate transceivers. Therefore, the application provides clear support for

Dr. Boesen

Attorney Docket No. P03999US8

simultaneous sending and receiving which satisfies MPEP § 608.01(o). The Examiner is directed towards page 5, last four lines through page 6, line 7 which state

"... [T]he air conduction sensor 30 and the bone conduction sensor 24 are in operative connection with a transceiver 52. Although a single stereo transceiver is shown, the present invention also contemplates that multiple transceivers could be used to transmit the air conduction signal and the bone conduction signal on separate channels. The present invention also contemplates that the air conduction sensor and the bone conduction sensor signals can be combined and any a number of ways so that they may be transmitted from a single transceiver and then received and separated."

Therefore, the Specification clearly discloses simultaneously transmitting. Therefore, this objection must be withdrawn.

Issue Under 35 U.S.C. § 112

Claim 19 has been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner references the limitation of "simultaneously transmitting" in line 11 of claim 19 (Office Action, page 2).

For the reasons previously expressed, this subject matter is described in the Specification in a manner that reasonably conveys to one skilled in the relevant art that the inventor had possession. There is no requirement of *in haec verba* support. *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774 (Fed. Cir. 2002). Therefore, this rejection should be withdrawn.

Dr. Boesen

Attorney Docket No. P03999US8

Issues Under 35 U.S.C. § 103

Claims 1-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,721,783 to Anderson in view of U.S. Patent No. 6,048,305 to Bauman.

Bauman is directed towards an open ear auditory pathway stimulator to manage tinnitus and hyperacusis (Abstract). In Bauman, a structure is disclosed that places a portion of the housing of the device against the posterior superior wall and allows an unobstructed air pathway along the posterior inferior wall (Figure 1). The purpose of this position is so that Bauman can emit sound waves from a receiver aimed at the superior portion of the tympanic membrane while avoiding wax build-up and an occlusive effect (col. 6, lines 22 to 46).

The Examiner states that "it would have been obvious for one of ordinary skill in the art at the time of the invention to substitute the housing structure in Figure 1 or Figure 4 of Bauman for the housing structure in Figure 1 of Anderson, thereby allow ambient sound into the external auditory canal and to avoid the occlusion effect" citing Bauman, col. 6, lines 31-36. (Office Action, page 3, last three lines through page 4, line 3). * The Examiner does not make a *prima facie* case of unpatentability because there is no motivation or suggestion to combine from either reference.

*I
Housing
Substitution*

In Bauman, the device is pressed against the posterior superior wall to aim the receiver at the tympanic membranes (col. 6, lines 43-46). Bauman does not disclose any type of bone sensing, and is directed towards a very different type of problem.

Further, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination." MPEP § 2143.01 citing In re Mills, 916 F.2d 680; 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Anderson does not indicate any particular desirability for nonocclusivity. Bauman disclose

Dr. Boesen

Attorney Docket No. P03999US8

nonocclusivity, but is not directed to an earpiece or sensing bone conduction signals. Therefore, this rejection should be withdrawn.

There is also an independent reason for patentability of claim 1. Neither Anderson nor Bauman disclose a bone conduction sensor "fitted to the contours of a posterior superior wall of an external auditory canal." Therefore, this rejection should be withdrawn on that basis as well. As claims 2-6 depend from claim 1, it is respectfully submitted that these claims are also allowable.

Claim 7 now requires "sensing a bone conduction signal from a bone conduction sensor nonocclusively disposed within the external auditory canal of the user and positioned against the posterior superior wall of the external auditory canal." Therefore, claim 7 should be allowed due to the deficiency of Bauman and Anderson that have been previously expressed. As claims 8-11 depend from claim 7, it is respectfully submitted that these rejections should also be withdrawn.

Claims 12-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,721,783 to Anderson in view of U.S. Patent No. 6,048,305 to Bauman and further in view of U.S. Patent No. 5,692,059 to Kruger. It is respectfully submitted that these rejections should also be withdrawn. The differences of the Anderson and Bauman references have already been discussed. Neither teaches a nonocclusive earpiece with a bone conduction sensor. The Examiner does not indicate proper motivation or suggestion to combine and therefore fails to make a *prime facie* case. Therefore, it is respectfully submitted that these rejections should also be withdrawn for that independent reason.

Dr. Boesen

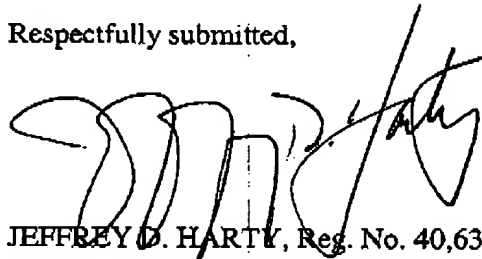
Attorney Docket No. P03999US8

Conclusion

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for two months from October 23, 2003 to December 23, 2003. Applicant is a small entity; therefore, please charge Deposit Account No. 26-0084 in the amount of \$210.00 for two months to cover the cost of the extension in addition to the cost of filing the Request for Continued Examination (RCE) in the amount of \$385.00. Any deficiency or overpayment should be charged or credited to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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